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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,696	01/05/2004	David S. Smith	220907102003B	1695
26496	7590	07/28/2005		
			EXAMINER	
			FIDEI, DAVID	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/707,696	SMITH, DAVID S.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David T. Fidei	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 January 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/5/2004.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a) because the photographs fail to provide a showing of any appreciable detail. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing, MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Construction***

2. In analyzing applicant's invention as set out in the pending claims, the examiner sets forth the following to aid in understanding the application of the prior art herein. Claims are to be given their broadest reasonable during prosecution, see *In re Priest*, 582 F.2d 33, 37 199 USPQ 11, 15 (CCPA 1978), and limitations from the specification will not be read into the claims, see, e.g. *In re Prater*, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969). Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997), see MPEP 2106.

Applicant sets forth their invention as a case "for" storing circular saw blades. In order to further limit the claim there must be some distinction based upon the intended use recited. "However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art, see M.P.E.P. § 2111.02 THE INTENDED USE MAY FURTHER LIMIT THE CLAIM IF IT DOES MORE THAN MERELY STATE PURPOSE OR INTENDED USE. The examiner can see no structural differences between the claimed invention and the prior art based upon the intended use recited.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Winnard (Patent no. 5,725,096). In figure 8 a case for carrying circular saw blades is disclosed in as much as is claimed comprising at least two storage trays 102, and the tray with 604 having inserts 200 within the tray that alter the diameter of the trays as recited in claims 1 and 6.

As to claims 4 and 7, the pull mechanism of for the drawer is considered the lip just below the drawer top that also serves as the handle.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Winnard (Patent no. 5,725,096). In figure 8 a case for carrying circular saw blades is disclosed in as much as is claimed comprising at least two storage trays 102, and the tray with 604 having inserts 200 within the tray that alter the diameter of the trays as recited in claims 1 and 6.

As to claims 4 and 7, the pull mechanism of for the drawer is considered the lip just below the drawer top that also serves as the handle. To the extent that the toolbox of Winnard is not seen as having a pull drawer or a latching mechanism, these features are conventional in the toolbox art. Where a key locks a top cover in place along with the drawers below and a recess

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under a top front portion of the drawer serves as a grip to slid the drawer out. It would have been obvious to one of ordinary skill in the art to construct the toolbox with such features in order to permit access to the drawer items by gripping some type of handle structure along with enabling the contents to be secured.

7. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piperoux (Patent no. 1,992,630) in view of Winnard (Patent no. 5,725,096). Piperoux discloses a case comprising at least two storage trays 14, 13 having a pivot pin 26 in communication with at least two trays. The difference between the claimed subject matter and Piperoux resides in the storage trays provided with inserts.

Winnard (Patent no. 5,725,096) teaches the use of inserts 200 provided in trays as discussed above. It would have been obvious to one of ordinary skill in the art to modify the display case of Piperoux by providing inserts as suggested by Winnard, order to provide organized retention of articles therein.

As to claim 3, the pivot pin is considered located along the outer circumference of the tray as shown in figure 3. In figure 8 a case for carrying circular saw blades is disclosed in as much as is claimed comprising at least two storage trays 102, and the tray with 604 having inserts within the tray that alter the diameter of the trays as recited in claims 1 and 6.

As to claim 5, a latch 32 is disclosed.

#### *Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the diameter" in 5 and claim 3 recites the circumference in line 2. There is insufficient antecedent basis for this limitation in the claim.

If applicant to intends to prosecute the present application by only amending the claims to provide antecedent basis for these terms, they are advised the Examiner considers the shape of trays to be of no particular patentable significance, since whether one employs a polygonal or round to be a matter of design choice. Since it is unknown what applicant originally intended the issue has not been addressed but these comments provided in order to provide some guidance.

**Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
July 25, 2005